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11 UNITED STATES DISTRICT COURT
12 NORTHERN DISTRICT OF CALIFORNIA
13 SAN FRANCISCO DIVISION

15 JOBY, INC.,

16 Plaintiff,

17 v.

18 TOCAD AMERICA, INC.,

19 Defendant.

Case No. 3:07-CV-06455 (SI)

**REQUEST FOR JUDICIAL NOTICE IN
SUPPORT OF JOBY, INC.'S MOTION
TO DISMISS**

Date: June 6, 2008
Time: 9:00 a.m.
Courtroom: 10, 19th Floor
The Honorable Susan Illston

Pursuant to Rule 201 of the Federal Rules of Evidence, and in connection with Joby, Inc.'s Motion to Dismiss filed concurrently herewith, Joby, Inc. ("Joby") hereby requests that the Court take judicial notice of the following documents:

1. **Bevirt Declaration:** December 12, 2006 Information Disclosure Statement filed by Joby with the U.S. Patent and Trademark Office ("PTO") for Patent Application No. 11/324,994 (Publication No. 20070154254), including the declaration of Joe Ben Bevirt dated November 21, 2006. (*See* Declaration of Virginia K. DeMarchi in Support of Joby, Inc.'s Motion to Dismiss to Dismiss Defendant Tocad America, Inc.'s Counterclaim ("DeMarchi Decl."), Ex. A.)
2. **Final Office Action:** January 25, 2008 final office action issued by the PTO rejecting the pending claims in Patent Application No. 11/324,994 (Publication No. 20070154254). (DeMarchi Decl. Ex. B.)
3. **Response to Final Office Action:** April 18, 2008 response to final rejection and request for continuing examination filed by Joby with the PTO for Patent Application No. 11/324,994 (Publication No. 20070154254). (DeMarchi Decl. Ex. C.)

I. JUDICIAL NOTICE OF DOCUMENTS REFERENCED IN THE COUNTERCLAIM

The Court may take judicial notice of documents specifically referenced in Tocad's counterclaim, but not attached to the pleading, provided the authenticity of the documents is not in dispute. *See, e.g., In re Tibco Software, Inc. Secs. Litig.*, No. C 05-2146 SBA, 2006 U.S. Dist LEXIS 36666, *48 (N.D. Cal. May 24, 2006); *Wietschner v. Monterey Pasta Co.*, 294 F. Supp. 2d 1102, 1109 (N.D. Cal. 2003). Such notice may be taken in the context of a motion to dismiss pursuant to Rule 12(b)(6), without converting the motion to one for summary judgment, so that the Court may determine whether a claimant has alleged facts sufficient to state a claim. *See, e.g., Parrino v. FHP, Inc.*, 146 F.3d 699, 706 (9th Cir. 1998), *cert denied*, 525 U.S. 1001 (1998); *Graphic Arts Sys. v. Scitex Am. Corp.*, No. CV 92-6997-WMB, 1993 U.S. Dist. LEXIS 21052, *12-13 (C.D. Cal. May 25, 1993); *Medimatch, Inc. v. Lucent Techs., Inc.*, 120 F. Supp. 2d 842, 847 (N.D. Cal. 2000).

Tocad's counterclaims assert state law claims for tort liability based on Joby's prosecution of Patent Application No. 11/324,994 (Publication No. 20070154254) and its communications with potential infringers about provisional rights in the invention claimed in the application. The counterclaim specifically refers to, and characterizes, the Bevirt Declaration (DeMarchi Decl. Ex. A) and the Final Office Action (DeMarchi Decl. Ex. B), but neither of these documents is attached to the counterclaims. (See Counterclaim ¶¶ 6, 8.) Both documents are available from the PTO's public Patent Application Information Retrieval ("PAIR") system, which may be accessed at <http://portal.uspto.gov/external/portal/pair>. The authenticity of these documents is not subject to dispute. Joby asks that the Court take judicial notice of both documents so that the Court may consider their actual contents in assessing whether Tocad has stated cognizable claims for relief and whether such claims are ripe for adjudication.

II. JUDICIAL NOTICE OF DOCUMENTS AND MATTERS OF PUBLIC RECORD

The Court may also take judicial notice of "matters of public record." See *Lee v. City of Los Angeles*, 250 F.3d 668, 689-90 (9th Cir. 2001) (on a motion to dismiss the court may take judicial notice of matters of public record, such as the fact of a hearing or a court filing); see also *Bd. of Trs. v. Hill*, No. C 07-05849 CW, 2008 U.S. Dist. LEXIS 9193, at *15-16 n.5 (N.D. Cal. Jan. 28, 2008) (court may notice the filing of court records); *Grassmuck v. Johnson Controls Battery Group, Inc.*, No. CV-06-526-ST, 2007 U.S. Dist. LEXIS 3787, at *2-3 (D. Or. Jan. 18, 2007) (taking judicial notice of court filing); *In Re Copper Mountain Secs. Litig.*, 311 F. Supp. 2d 857, 863 (N.D. Cal. 2004) (notice of documents filed with the SEC). On a motion to dismiss pursuant to Rule 12(b)(1), the Court "need not accept as true allegations that contradict matters properly subject to judicial notice." *In Re Copper Mountain*, 311 F. Supp. 2d at 865; see also *Inter-Mark USA, Inc. v. Intuit, Inc.*, No. C-07-04178 JCS, 2008 U.S. Dist. LEXIS 18834, at *17 (N.D. Cal. Feb. 27, 2008) (on a motion to dismiss the "Court may also consider documents of which it has taken judicial notice").

Tocad's counterclaims include various assertions about the status of Joby's pending patent applications. The PTO's publicly accessible PAIR service provides information to the public about the status of pending applications, the actions taken by the PTO and the filings made by the

applicant. *See* UNITED STATES PATENT AND TRADEMARK OFFICE, U.S. DEPARTMENT OF
 COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE at §§ 102, 203.08, 1730(II)(B)(1)(c)
 (September 2007). The authenticity of these publicly recorded documents and related data is not
 subject to dispute. Accordingly, Joby asks that the Court take judicial notice of the Response to
 the Final Office Action filed by Joby on April 18, 2008 (DeMarchi Decl. Ex. C) and the other
 data available on PAIR reflecting the history and status of the prosecution of Joby's Patent
 Application No. 11/324,994 (Publication No. 20070154254).

Dated: April 30, 2008

FENWICK & WEST LLP

By: /s/Virginia K. DeMarchi
 Virginia K. DeMarchi

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 JOBY, INC.

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